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10/623,443

07/18/2003

Karen Luke

2000-IP-002115U1P1

4704

28857

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04/10/2008

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EXAMINER

FIGUEROA, JOHN J

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

04/10/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/623,443

**Applicant(s)**

LUKE ET AL.

**Examiner**

John J. Figueroa

**Art Unit**

1796

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 138 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33, 40, 43-47, 49, 53-55, 58, 61, 62, 65, 106, 110, 113-121, 125, 128-132 and 134-137 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-848)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 11/28/07 & 1/9/08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims pending in the application are 33,40,43-47,49,53-55,58,61,62,65,106,110,113-121,125,128-132 and 134-138.

## **DETAILED ACTION**

### ***Response to Amendment***

1. The 35 U.S.C. 102(b) rejection of claims 33, 40-45, 47, 49, 55, 58, 61, 65, 106, 110, 113-116, 120, 135 and 136 as anticipated by USPN 4,986,989 to Sirocita et al. (hereinafter 'Sirocita') previously made of record in item 3 on page 2 of the Office Action of October 9, 2007 (hereinafter 'OA') has been withdrawn in view of Applicant's amendment to independent claims 33, 106 and 121 in the response to OA filed January 9, 2008 (hereinafter 'Response').
2. The 35 U.S.C. 103(a) rejection of claims 33, 40, 43-47, 49, 53-55, 58, 61, 62, 65, 106, 110, 113-121, 125, 128-132 and 134-137 as unpatentable over USPN 4,548,734 to Chaux et al. (hereinafter 'Chaux') has been maintained for reasons previously made of record in items 5 and 12 on pages 3 and 5, respectively, of OA.
3. The obviousness type double patenting rejections that were previously made of record in item 7 of OA have been withdrawn in view of Applicant's amendment to the claims in Response.

### ***Election/Restrictions***

4. Claim 138 had been withdrawn from consideration for prosecution on the merits as constructively elected by original presentation in item 8 of OA. This election/restriction is deemed proper and is made Final.

***Response to Arguments***

***The 35 U.S.C. 102(b) Rejection over Sirosita (item 3 of OA)***

5. Applicant's arguments with respect to the captioned 35 U.S.C. 102(b) rejection of claims as anticipated by Sirosita have been fully considered but deemed moot due to the withdrawal of this rejection in view of Applicant's amendment to the claims. The independent claims, as amended, now limit the zeolite component to be of a general formula that does not encompass the copper-zeolite complex disclosed in Sirosita.

***The 35 U.S.C. 103(a) Rejection over Chaux (item 6 of OA)***

6. Applicant's arguments with respect to the captioned 35 U.S.C. 103(a) rejection of claims 33, 40, 43-47, 49, 53-55, 58, 61, 62, 65, 106, 110, 113-121, 125, 128-132 and 134-137 as unpatentable over Chaux have been fully considered but deemed unpersuasive.

Applicant's arguments that the current amendment to independent claims 33, 106 and 121 overcomes this rejection because Chaux does not teach the zeolite component of its disclosed formulation to be a zeolite encompassed by the general chemical formula added to the independent claims are incorrect.

Applicant discloses in paragraph [0013] on page 3 of the present specification that the chemical formula currently added to the claims is representative of "all zeolites", natural or manmade. Accordingly, this formula now present in the claims would

encompass the representative natural zeolites, and exemplary synthetic zeolites, taught by Chaux in col. 7, lines 16-17.

More importantly, Chaux discloses in col. 7, lines 29-36 that analcime, chabazite, clinoptilolite, heulandite, natrolite, brewsterite, faujasite, harmotome, laumontite, mesolite, phillipsite, scolecite, stillbite and thomsonite are exemplary natural zeolites for the composition. These 14 zeolites listed in Chaux are among the 17 zeolites that the present specification teaches as "preferred zeolites" in paragraph [0014] on page 3. In addition, the first five listed of these 14 zeolites disclosed in Chaux are recited in present claims 40, 110 and 125 as limiting the zeolite component of their respective independent claims.

Consequently, Chaux is disclosing the composition as containing zeolites encompassed by the general zeolite formula recited in the instant independent claims.

In response to Applicant's argument regarding Chaux not disclosing the zeolite component in the composition to be within the range limitation recited in the claims (about 60 to 70 percent of dry materials of the composition), this was addressed previously in item 12 on pages 5 and 6 of OA as incorrect.

As mentioned in item 12 of OA, Chaux discloses in, col. 11, lines 37-42, a formulation wherein the zeolite component of the composition can be present in a range of 7 to 40% of the composition; surfactant in a range 0 to 10% (optional); and water in a range of 15 to 37%. The zeolite in this formulation can thereby be present in, e.g., 40%, the surfactant 1% and water 37%. If so, it is present in an amount 40/(100-38) of the *dry materials*, which is about 65%. Even including the water-soluble gum component

(30-70%) as part of the dry mix (i.e., it is not dissolved in water first before adding it to the solution), this embodiment of Chaux's formulation would provide a composition having 40% zeolite present, 30% water-soluble gum 30% and the balance water/surfactant. The zeolite would thus be present in amount of 57.2%, which is within "about 60%".

Further, it is uncertain from the specification as to what the definition of "dry mix" actually encompasses. In paragraph [0042] on page 8 of the present specification, Applicant discloses that "in one embodiment, the zeolite-containing well bore treating fluid may be prepared as a *dry mix including some or all of the above-identified components*, except for the carrier fluid." Consequently, because the term "dry mix" is not defined in the claims and the present specification teaches that "dry mix" can be interpreted as including the zeolite component and one or more of the disclosed additives, it is uncertain why Chaux's formulation would not encompassed by the range limitation for the weight percentage of zeolite in the instant independent claims.

In response to Applicant's arguments that the composition in Chaux is not disclosed as used as a well bore spacer fluid, this is a recitation of an intended future use of the claimed invention. An intended future use of the composition must result in a structural difference between the claimed composition and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art chemical composition is capable of performing this intended use (well treatment), then it meets the claim.

Thus, the instant claims, as amended, remain unpatentable over Chaux.

*The Obviousness-Type Double Rejections (items 10-12 of FOA)*

7. Applicant's arguments with respect to the captioned double patenting rejections have been considered but deemed moot in view of the withdrawal of these rejections in view of Applicant's amendment to the claims.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Figueroa whose telephone number is (571) 272-8916. The examiner can normally be reached on Monday-Thursday 8:00-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JJF/RAG

/Randy Gulakowski/

Supervisory Patent Examiner, Art Unit 1796